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10/540,381

06/23/2005

Isador H Lieberman

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2535

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11/26/2007

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

11/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/540,381

Applicant(s)

LIEBERMAN, ISADOR H

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Uhl et al. (4,881,534) in view of Mears (2003/0100905) in view of Sfakianos et al. (5,443,474).

Uhl et al discloses a an apparatus (24) for cutting bone comprising a shaft (10) having a central axis and extending between a proximal end portion (12) and a distal end portion, the proximal end portion having a first surface adapted for receiving repetitive impacts, as set forth in column 4, lines47-50, the distal end portion (11) including a cutting blade (16) extending between a shield section and a guide section, the shield section and the guide section being oppositely disposed about the central axis (if a line is drawn through FIG.1 in the device of Uhl et al, the shield section and the guide section would be oppositely disposed about the central axis) the shield section including a inward facing shield surface (15) which extends in a second plane that is transverse to the first plane of the cutting blade, the shield section includes an arcuate end surface (18) for sliding underneath soft tissues present on the outer peripheral surface of the bone of the shaft member is advanced, the shield surface functioning as a shield for the cutting blade to prevent undesired cutting of the soft tissue, wherein the shield includes an outwardly facing ramp surface (17) for cooperating with the arcuate

end surface to lift the soft tissue off of the outer peripheral surface of the bone as the shaft member is advanced, the guide section is narrower in width than the shield section. The apparatus is capable of being used for cutting through the cortical bone of a vertebral body.

It is noted that, Uhl et al did not teach of an apparatus wherein the shield section and the guide section projecting axially beyond the cutting blade to recess the cutting blade in the distal end portion and the guide section comprising a blunt tooth; as claimed by applicant. However, in a similar art, Mears evidences the use of a cutter having a blade that is recessed within two cutting guides each including a bulbous tooth to prevent objects from contacting the blade.

Therefore, given the teaching of Mears, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the distal end cutter of Uhl et al, as taught by Mears, to prevent objects from contacting the blade.

It is noted that the above combination of references did not teach of an elongate member that includes an arcuate cutting blade extending between first and second tip portions; as claimed by applicant. However, in a similar art, Sfakianos et al evidences the use of an arcuate blade between first and second tip portions to reduce the risk of stray cuts and damage to surrounding tissue.

Therefore, given the teaching of Sfakianos et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Uhl/Mears, as taught by Sfakianos et al to reduce the risk of stray cuts and damage to surrounding tissue.

***Response to Amendment***

Applicant's arguments filed 9/18/07 have been fully considered but they are not persuasive. Applicant's amendment to claim 1, did not overcome the rejection in the last office action; because if a central axis is drawn to FIG.1 of Uhl et al the shield section and the guide section would be on opposite side of the central axis. As to the argument that Uhl et al did not teach of a guide section, the examiner begs to differ, since the reference (14) of Uhl et al could be considered to be a guide section. Applicant is only claiming a guide section and there is no definition of a guide section; therefore, the reference (14) of Uhl et al, as broadly interpreted, could be considered as a guide section. As to the arguments that none of the references teaches of an arcuate blade, the reference to Sfakianos et al discloses an arcuate blade to reduce the risk of stray cuts and damage to surrounding tissue. Therefore, given the teaching of Sfakianos et al it would have been obvious to combine the device of Uhl/Mears with the device of Sfakianos et al to reduce the risk of stray cuts and damage to the surrounding tissue.

***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
November 20, 2007

  
PEDRO PHILOGENE  
EXAMINER